

ATTORNEY DOCKET NO.: 2003080-0143 (SK-744-CON9)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Danishefsky *et al.* Examiner:  
Serial No.: 10/726,386 Art Unit:  
Filing Date: December 2, 2003  
Title: Synthesis of Epothilones, Intermediates Thereto, Analogues and Uses  
Thereof

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

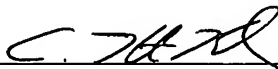
TRANSMITTAL LETTER

Enclosed are the following documents:

1. Form PTO-1449 (22 pages);
2. Information Disclosure Statement (6 pages); and
3. Return Postcard

If any additional fees are required to be paid or if any overpayment has been made, please charge same to Deposit Account No. 03-1721.

Respectfully submitted,

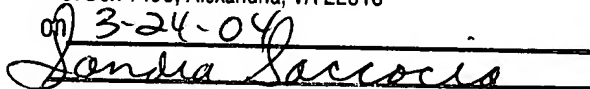
  
C. Hunter Baker, M.D., Ph.D.  
Registration No. 46,533

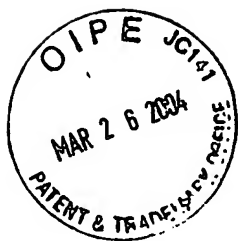
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Exchange Place  
53 State Street  
Boston, MA 02109  
(617) 248-5000

**Dated: March 24, 2004**

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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Title: Synthesis of Epothilones, Intermediates Thereto, Analogues and Uses  
Thereof

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**STATEMENT**

Pursuant to the duty of disclosure under 37 C.F.R. §§1.56, 1.97 and 1.98, Applicant  
requests consideration of this Information Disclosure Statement.

**Type of Statement**

The present Information Disclosure Statement is:

- ☒ An *original* Information Disclosure Statement; or  
☐ A *supplemental* Information Disclosure Statement.

**Certificate of Mailing**

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Sandra Saccocia

Signature

Sandra Saccocia

Typed or Printed Name of person signing certificate

Compliance with 37 CFR § 1.97

The present Information Disclosure Statement is being filed:

- ☒ Pursuant to 37 CFR § 1.97(b); no fee or certification is required:
  - ☐ Within three months of the filing date of a national application other than a continued prosecution application under § 1.53(d);
  - ☐ Within three months of the date of entry of the national stage as set forth in § 1.491 in an international application;
  - ☒ Before the mailing of a first Office action on the merits; or
  - ☐ Before the mailing of a first Office action after the filing of a request for continued examination under § 1.114.
- ☐ Pursuant to 37 CFR § 1.97(c) after the dates listed above but before the mailing date of any of a final action under § 1.113, a notice of allowance under § 1.311, or an action that otherwise closes prosecution in the application; Applicant hereby *either*:
  - ☐ Certifies that *either*:
    - ☐ each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement; or
    - ☐ That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the

knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in § 1.56(c) more than three months prior to the filing of the information disclosure statement.; or

☐ Includes herewith the fee set forth in § 1.17(p).

☐ Pursuant to 37 CFR § 1.97(d), after the mailing date of any final action under § 1.113, a notice of allowance under § 1.311, or an action that otherwise closes prosecution in the application; Applicant hereby *both*:

☐ Certifies that *either*:

☐ each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement; or

☐ That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in § 1.56(c) more than three months prior to the filing of the information disclosure statement.; and

☐ Includes herewith the fee set forth in § 1.17(p).

### Content of the Information Disclosure Statement

Applicant hereby makes of record in the above-identified application the reference(s) listed on the attached form PTO-1449 (modified). The order of presentation of the references should not be construed as an indication of the importance of the references.

Applicant includes copies of references as indicated below:

- ☐ A copy of each cited reference not indicated with an asterisk is included;
- ☒ Copies of references indicated with an asterisk on the attached form PTO-1449 are not included pursuant to 37 CFR § 1.98(d) because they were previously provided to the United States Patent Office in an Information Disclosure Statement that complies with 37 CFR § 1.98(a)-(c) and was submitted in the following patent application that is relied upon in the present case for an earlier effective filing date under 35 USC § 120:

Serial Number	Filing Date	Status
10/695,582	October 28, 2003	Pending

- ☐ Copies of English translations of one or more non-English references are included.

Applicant hereby makes the following additional information of record in the above-identified application:

Applicant certifies that the Information Disclosure Statement *either*:

- ☒ Does not contain non-English language citations;
- ☐ Does contain non-English language citations, for which an English language abstract is submitted.

[ ] Does contain non-English language citations which were cited on an International Search Report (a copy of which is enclosed herewith).

[ ] Includes one or more translations of a non-English citation.

Remarks

The submission of this Information Disclosure Statement should not be construed as a representation that a search has been made.

The submission of this Information Disclosure Statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in § 1.56(b) .


The submission of this Information Disclosure Statement shall not be construed as a representation that the information cited in the Statement is, or is considered to be, in fact, prior art as defined by 35 U.S.C. §102.

It is respectfully requested that:

1. The Examiner consider completely the cited information, along with any other information, in reaching a determination concerning the patentability of the present claims;
2. The enclosed form PTO-1449 be signed by the Examiner to evidence that the cited patent(s) and publication(s) has (have) been fully considered by the Patent and Trademark Office during the examination of this application; and
3. The citations for the patent(s) and publication(s) be printed on any patent which issues from this application.

Notwithstanding any statements by Applicants, the Examiner is urged to form his or her own conclusions regarding the relevance of the cited reference(s).

Respectfully submitted,

  
\_\_\_\_\_  
C. Hunter Baker, M.D., Ph.D.  
Reg. No. 46,533

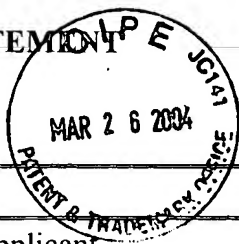
CHOATE, HALL & STEWART  
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53 State Street  
Boston, Massachusetts 02109  
(617) 248-5000  
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Dated: 3/24/04

3671132

**INFORMATION DISCLOSURE STATEMENT**

(Use several sheets if necessary)



APPLICANT: Danishefsky *et al*

FILING DATE:  
December 2, 2003

GROUP:

**U.S. PATENT DOCUMENTS**

Examiner's Initials	U.S. Patent No.	Applicant	Issue Date	Class	Subclass
	*6,090,601	Gustafsson	July 18, 2000	435	183
	*6,096,757	Bishop	August 1, 2000	514	290
	*6,117,659	Ashley	September 12, 2000	435	155
	*6,121,029	Schupp	September 19, 2000	435	183
	*6,211,412	Georg	April 3, 2001	568	309
	*6,221,641	Khosla	April 24, 2001	435	193
	*6,251,636	Betlach	June 26, 2001	435	76
	*6,262,107	Li	July 17, 2001	514	449
	*6,280,999	Gustafsson	August 28, 2001	435	252.3
	*6,407,103	Nugiel <i>et al.</i>	June 18, 2002	514	232.8
	*6,489,314	Ashley <i>et al.</i>	December 3, 2002	514	183
	*6,498,257	Vite <i>et al.</i>	December 24, 2002	548	205
	*6,515,017	Li <i>et al.</i>	February 4, 2003	514	449
	*6,518,421	Li <i>et al.</i>	February 11, 2003	540	462
	*6,525,197	Furstner <i>et al.</i>	February 25, 2003	544	310
	*6,531,497	Nicolaou <i>et al.</i>	March 11, 2003	514	370
	*6,537,988	Lee	March 25, 2003	514	221
	*6,538,038	Pero <i>et al.</i>	March 25, 2003	514	731
	*6,544,544	Hunter <i>et al.</i>	April 8, 2003	424	424
	*6,576,651	Bandyopadhyay <i>et al.</i>	June 10, 2003	514	365
	*6,593,115	Vite <i>et al.</i>	July 15, 2003	435	134
	*6,596,875	White <i>et al.</i>	July 22, 2003	568	204
	*6,603,015	Georg <i>et al.</i>	August 5, 2003	548	204
	*6,603,023	Danishefsky <i>et al.</i>	August 5, 2003	549	346
	*6,605,599	Vite <i>et al.</i>	August 12, 2003	514	63
	*6,605,726	Mulzer <i>et al.</i>	August 12, 2003	548	202
	*6,610,736	Klar <i>et al.</i>	August 26, 2003	514	450
	*6,613,912	Hoefle <i>et al.</i>	September 2, 2003	548	204

<b>FORM PTO-1449</b> <b>(REV. 8-83)</b>			U.S. Department of Commerce Patent and Trademark Office		ATTY. DOCKET: 2003080-0143 (SK-744-CON9)		IN RE APPLICATION NO.: 10/726,386	
<b>INFORMATION DISCLOSURE STATEMENT</b> (Use several sheets if necessary)					APPLICANT: Danishefsky <i>et al</i>			
					FILING DATE: December 2, 2003		GROUP:	
	*6,624,310	Hoefle et al.	September 23, 2003		548	204		
	*6,664,288	Pardee et al.	December 16, 2003		514	449		
	*6,670,384	Bandyopadhyay et al.	December 30, 2003		514	365		
	*6,683,100	Van Hoogevest	January 27, 2004		514	365		
<b>U.S. PATENT APPLICATIONS</b>								
Examiner's Initials:	Serial Number:	Applicant:	Publication Date:		Group:	Art Unit:		
	*2002/0086812	Schweinfest et al.	July 4, 2002					
	*2002/0091269	Avery	July 11, 2002					
	*2002/0094991	Gallaher	July 18, 2002					
	*2002/0115686	Hoogevest	August 22, 2002					
	*2002/0119202	Hunter et al.	August 29, 2002					
	*2002/0137152	Santi et al.	September 26, 2002					
	*2002/0147197	Newman et al.	October 10, 2002					
	*2002/0156110	Arslanian et al.	October 24, 2002					
	*2002/0156289	Georg et al.	October 24, 2002					
	*2002/0164377	Hunter et al.	November 7, 2002					
	*2002/0165258	Lee	November 7, 2002					
	*2002/0165256	Hofmann et al.	November 7, 2002					
	*2002/0165257	Lee	November 7, 2002					
	*2002/0165265	Hunter et al.	November 7, 2002					
	*2002/0165415	Georg et al.	November 7, 2002					
	*2002/0169125	Leung et al.	November 14, 2002					
	*2002/0169135	Pardee et al.	November 14, 2002					
	*2002/0169190	Bandyopadhyay et al.	November 14, 2002					
	*2002/0177615	Bandyopadhyay et al.	November 28, 2002					
	*2002/0192778	Schupp et al.	December 19, 2002					
	*2002/0193361	Ashley et al.	December 19, 2002					
	*2002/0197261	Li et al.	December 26, 2002					
	*2002/0198141	McChesney et al.	December 26, 2002					

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<b>INFORMATION DISCLOSURE STATEMENT</b> <i>(Use several sheets if necessary)</i>					APPLICANT: Danishefsky <i>et al</i>			
					FILING DATE: December 2, 2003		GROUP:	
	*2003/0232968	Li et al.	December 18, 2003					
	*2003/0232837	Guzi et al.	December 18, 2003					
	*2003/0232416	Wong et al.	December 18, 2003					
	*2003/0235855	Cabral	December 25, 2003					
	*2003/0166507	Li et al.	September 4, 2003					
	*2003/0158412	Westermann et al.	August 21, 2003					
	*2003/0149281	Westermann et al.	August 7, 2003					
	*2003/0147807	Li et al.	August 7, 2003					
	*2003/0144533	Iwasaki et al.	July 31, 2003					
	*2003/0144523	Klar et al.	July 31, 2003					
	*2003/0139460	Schwede et al.	July 24, 2003					
	*2003/0134883	Myles et al.	July 17, 2003					
	*2003/0130178	Li et al.	July 10, 2003					
	*2003/0130170	Li et al.	July 10, 2003					
	*2003/0124055	Li et al.	July 3, 2003					
	*2003/0125362	Danishefsky	July 3, 2003					
	*2003/0113335	Li et al.	June 19, 2003					
	*2003/0114363	Li et al.	July 3, 2003					
	*2003/0114450	Santi et al.	June 19, 2003					
	*2003/0114504	Webster et al.	June 19, 2003					
	*2003/0114518	Li et al.	June 19, 2003					
	*2003/0105330	Danishefsky et al.	June 5, 2003					
	*2003/0109500	Pero et al.	June 12, 2003					
	*2003/0096381	Julien et al.	May 22, 2003					
	*2003/0087888	Regueiro-Ren et al.	May 8, 2003					
	*2003/0073677	Lee	April 17, 2003					
	*2003/0073617	Li et al.	April 17, 2003					
	*2003/0073615	Li et al.	April 17, 2003					
	*2003/0073205	Arsanian et al.	April 17, 2003					
	*2003/0069277	Danishefsky et al.	April 10, 2003					
	*2003/0060623	Vite et al.	March 27, 2003					
	*2003/0054977	Kumar et al.	March 20, 2003					

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<b>INFORMATION DISCLOSURE STATEMENT</b> <i>(Use several sheets if necessary)</i>				APPLICANT: Danishefsky <i>et al</i>			
				FILING DATE: December 2, 2003		GROUP:	
	*2003/0049841	Short et al.	March 13, 2003				
	*2003/0045711	Ashley et al.	March 6, 2003				
	*2003/0036515	Pardee et al.	February 20, 2003				
	*2003/0036177	Strohacker	February 20, 2003				
	*2003/0023082	Ashley et al.	January 30, 2003				
	*2003/0004338	Li et al.	January 2, 2003				
	*2003/0004209	Hunter et al.	January 2, 2003				
	*2003/0003094	Hunter et al.	January 2, 2003				
	*2003/0191089	Regueiro-Ren et al.	October 9, 2003				
	*2003/0187273	White et al.	October 2, 2003				
	*2003/0187039	Favreau et al.	October 2, 2003				
	*2003/0186983	Mastalerz et al.	October 2, 2003				
	*2003/0186965	Vite et al.	October 2, 2003				
	*2003/0185831	Cutler et al.	October 2, 2003				
	*2003/0180760	Basch et al.	September 25, 2003				
	*2003/0176710	Klar et al.	September 18, 2003				
	*2003/0176473	Taylor et al.	September 18, 2003				
	*2003/0176368	Danishefsky	September 18, 2003				
	*2003/0176320	Li et al.	September 18, 2003				
	*2003/0166507	Li et al.	September 4, 2003				
	*2004/0014982	Hoefle et al.	January 22, 2004				
	*2004/0014978	Klar et al.	January 22, 2004				
	*2004/0006087	Cutler et al.	January 8, 2004				
	*2003/0166507	Li et al.	September 4, 2003				
	*2004/0019088	Lichtner et al	January 29, 2004				
	*2004/0018598	Santi et al.	January 29, 2004				
	*2004/0014982	Hoefle et al.	January 22, 2004				
	*2004/0014978	Klar et al.	January 22, 2004				
	*2004/0006087	Cutler et al.	January 8, 2004				
<b>FOREIGN PATENT DOCUMENTS</b>							
Examiner's Initials	Document No.	Country	Date	Translation			
				Yes	No		

<b>FORM PTO-1449</b> <b>(REV. 8-83)</b>			U.S. Department of Commerce Patent and Trademark Office		ATTY. DOCKET: 2003080-0143 (SK-744-CON9)		IN RE APPLICATION NO.: 10/726,386	
<b>INFORMATION DISCLOSURE STATEMENT</b> (Use several sheets if necessary)					APPLICANT: Danishefsky <i>et al</i>			
					FILING DATE: December 2, 2003		GROUP:	
	*DE 41 38 042	Germany	19 November 1991					
	*DE 41 38 042	Germany	19 November 1991					
	*DE 196 07 702	Germany	29 February 1996					
	*DE 196 36 343	Germany	30 August 1996					
	*DE 196 38 870	Germany	23 September 1996					
	*DE 196 47 580.5	Germany	18 November 1996					
	*DE 197 01 758	Germany	20 January 1997					
	*DE 197 07 506.1	Germany	25 February 1997					
	*DE 197 13 970	Germany	04 April 1997					
	*DE 197 20 312	Germany	15 May 1997					
	*DE 197 26 627	Germany	17 June 1997					
	*DE 197 35 574	Germany	09 August 1997					
	*DE 197 35 575	Germany	09 August 1997					
	*DE 197 35 578	Germany	09 August 1997					
	*DE 197 44 135	Germany	29 September 1997					
	*DE 197 49 717	Germany	31 October 1997					
	*DE 197 51 200	Germany	13 November 1997					
	*DE 198 13 821	Germany	20 March 1998					
	*DE 198 21 954	Germany	15 May 1998					
	*DE 198 33 750	Germany	16 July 1998					
	*DE 198 46 493	Germany	09 October 1998					
	*DE 198 30 060	Germany	30 June 1998					
	*DE 198 49 464	Germany	21 October 1998					
	*DE 199 07 588	Germany	22 February 22, 1999					
	*DE 199 08 763	Germany	18 February 1999					
	*DE 199 08 765	Germany	18 February 1999					
	*DE 199 21 086	Germany	30 April 1999					
	*DE 199 23 001	Germany	13 May 1999					
	*DE 199 30 111	Germany	01 July 1999					
	*DE 199 54 228	Germany	04 November 1999					
	*DE 199 54 230	Germany	04 November 1999					
	*DE 100 51 136	Germany	16 October 2000					

<b>FORM PTO-1449</b> <b>(REV. 8-83)</b>			U.S. Department of Commerce Patent and Trademark Office		ATTY. DOCKET: 2003080-0143 (SK-744-CON9)		IN RE APPLICATION NO.: 10/726,386	
<b>INFORMATION DISCLOSURE STATEMENT</b> <i>(Use several sheets if necessary)</i>					APPLICANT: Danishefsky <i>et al</i>			
					FILING DATE: December 2, 2003		GROUP:	
	*DE 100 15 836	Germany	27 March 2000					
	*DE 100 20 517	Germany	19 April 2000					
	*DE 100 20 899	Germany	20 April 2000					
	*EP 1 275 648	Europe	15 January 2003					
	*EP 1 201 666	Europe	02 May 2002					
	*EP 1 201 666	Europe	05 February 2002					
	*EP 1 186 606	Europe	13 March 2002					
	*EP 1 121 364	Europe	13 March 2002					
	*EP 1 087 975	Europe	27 August 2003					
	*EP 1 077 980	Europe	19 March 2003					
	*EP 1 042 327	Europe	17 September 2003					
	*EP 1 140 944	Europe	27 August 2003					
	*EP 1 340 498	Europe	03 September 2003					
	*EP 1 001 951	Europe	25 September 2002					
	*EP 0 975 638	Europe	07 August 2002					
	*EP 0 975 622	Europe	09 October 2002					
	*EP 0 903 348	Europe						
	*EP 0 873 341	Europe	10 September 2003					
	*199 08 760	DE	24 August 2000					
	*199 08 767	DE	19 October 2000					
	*WO 2004/007476	PCT	22 January 2004					
	*WO 03/105828	PCT	24 December 2003					
	*WO 03/103712	PCT	18 December 2003					
	*WO 03/084536	PCT	16 October 2003					
	*WO 03/078411	PCT	25 September 2003					
	*WO 03/077903	PCT	25 September 2003					
	*WO 03/076445	PCT	18 September 2003					
	*WO 03/075899	PCT	18 September 2003					
	*WO 03/074521	PCT	12 September 2003					
	*WO 03/074053	PCT	12 September 2003					
	*WO 03/070170	PCT	13 February 2002					
	*WO 03/057830	PCT	17 December 2002					

<b>FORM PTO-1449</b> <b>(REV. 8-83)</b>			U.S. Department of Commerce Patent and Trademark Office		<b>ATTY. DOCKET:</b> 2003080-0143 (SK-744-CON9)		<b>IN RE</b> <b>APPLICATION NO.:</b> 10/726,386	
<b>INFORMATION DISCLOSURE STATEMENT</b> <i>(Use several sheets if necessary)</i>					<b>APPLICANT:</b> Danishefsky <i>et al</i>			
					<b>FILING DATE:</b> December 2, 2003		<b>GROUP:</b>	
	*WO 03/057217	PCT	13 January 2003					
	*WO 03/053949	PCT	23 December 2002					
	*WO 03/049734	PCT	19 June 2003					
	*WO 03/045324	PCT	05 June 2003					
	*WO 03/042217	PCT	22 May 2003					
	*WO 03/029260	PCT	10 April 2003					
	*WO 03/029195	PCT	10 April 2003					
	*WO 03/026744	PCT	03 April 2003					
	*WO 03/018002	PCT	06 March 2003					
	*WO 03/014068	PCT	20 February 2003					
	*WO 03/014063	PCT	20 February 2003					
	*WO 03/007924	PCT	30 January 2003					
	*WO 02/46196	PCT	13 June 2002					
	*WO 02/42432	PCT	30 May 2002					
	*WO 02/32844	PCT	16 October 2001					
	*WO 02/30356	PCT	15 October 2001					
	*WO 02/098868	PCT	14 May 2002					
	*WO 02/080846	PCT	17 October 2002					
	*WO 02/074042	PCT	26 September 2002					
	*WO 02/072858	PCT	27 February 2002					
	*WO 02/072085	PCT	19 September 2002					
	*WO 02/067941	PCT	06 September 2002					
	*WO 02/066033	PCT	06 February 2002					
	*WO 02/066033	PCT	29 August 2002					
	*WO 02/062338	PCT	15 August 2002					
	*WO 02/060904	PCT	08 August 2002					
	*WO 02/058701	PCT	01 August 2002					
	*WO 02/058700	PCT	01 August 2002					
	*WO 02/058699	PCT	01 August 2002					
	*WO 01/81342	PCT	19 April 2001					
	*WO 01/81341	PCT	19 April 2001					
	*WO 01/73103	PCT	23 March 2001					

**INFORMATION DISCLOSURE STATEMENT**

*(Use several sheets if necessary)*

APPLICANT: Danishefsky *et al*

FILING DATE:  
December 2, 2003

GROUP:

	*WO 01/70716	PCT	12 March 2001		
	*WO 01/66154	PCT	09 March 2001		
	*WO 01/64650	PCT	01 March 2001		
	*WO 01/27308	PCT	06 October 2000		
	*WO 01/10412	PCT	02 August 2000		
	*WO 01/92255	PCT	06 December 2001		
	*WO 01/83800	PCT	08 November 2001		
	*WO 01/07439	PCT	24 July 2000		
	*WO 00/71521	PCT	15 May 2000		
	*WO 00/66589	PCT	01 May 2000		
	*WO 00/58254	PCT	23 March 2000		
	*WO 00/57874	PCT	20 March 2000		
	*WO 00/50423	PCT	17 February 2000		
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	*WO 00/49019	PCT	18 February 2000		
	*WO 00/047584	PCT	11 February 2000		
	*WO 00/39276	PCT	21 December 1999		
	*WO 00/37473	PCT	20 December 1999		
	*WO 00/31247	PCT	19 November 1999		
	*WO 00/00485	PCT	30 June 1999		
	*WO 99/67253	PCT	21 June 1999		
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<b>FORM PTO-1449</b> <b>(REV. 8-83)</b>  <b>INFORMATION DISCLOSURE STATEMENT</b> <i>(Use several sheets if necessary)</i>	U.S. Department of Commerce Patent and Trademark Office	ATTY. DOCKET: 2003080-0143 (SK-744-CON9)	IN RE APPLICATION NO.: 10/726,386
		APPLICANT: Danishefsky <i>et al</i>	
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